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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/659,046 06/03/96 BAUER

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EXAMINER

DEXTER, C

JOHN B. PEGRAM
FISH & RICHARDSON P.C.
45 ROCKEFELLER P.C.
NEW YORK NY 10111

ART UNIT

PAPER NUMBER

3724

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DATE MAILED: 12/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/659,046

Applicant(s)
Bauer et al.

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Oct 2, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 17 and 18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 17 and 18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 28

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. The amendment filed October 2, 2000 has been entered.

Information Disclosure Statement

2. The information disclosure statement filed September 26, 2000 (paper #28) has been received and the references listed thereon have been considered.

Claim Rejections - 35 USC § 112

3. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, line 1, the characterization of the claimed invention as “[A] device” renders the claimed subject matter vague and indefinite, particularly since it is not clear how the disclosed components (i.e., the first and second hand-held tools as claimed) comprise a single hand device when they appear to be separate tools that are being used together to perform a particular function.

In claim 18, line 1, “An arrangment” is vague and indefinite as to what is being claimed, i.e., it is not clear as to what structure “arrangement” implies or is intended to set forth.

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Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Merckens.

Merckens discloses a hand tool (e.g., in Figure 4) with every structural limitation of the claimed invention including a disc (e.g., at each end thereof) having opposing edges (e.g., 19) which are generally formed by a 90 degree intersection of two surfaces in the same manner as the

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present invention) formed by slot (e.g., formed by 19) of fixed dimensions which slot continuously narrows toward the center of the disc, and having a handle.

In the alternative, if it is argued that two of the tools are not disclosed, the Examiner takes Official notice that it is old and well known in the art to provide as many tools as necessary to perform a desired task or tasks. For example, it would have been obvious to one having ordinary skill in the art to provide two of Merckens' tools for various reasons including (1) having a second one as a backup in case a first one breaks or is lost, or (2) having a second one to provide to other users for performing other tasks. It is noted that the recitations directed to how the tools are used together (e.g., "said sides directly touching each other at said edges") has been given little patentable weight since it is clearly an intended use of the disclosed tools.

Further in the alternative, if it is argued that Merckens' tool does not disclose a disc because the term "disc" requires the head portion to be circular, and the head portion of Merckens is not circular, it is the Examiner's position that it would have been an obvious matter of design choice to one having ordinary skill in the art to make the head portions of the tool of Merckens circular since applicant has not stated that providing a circular head portion solves any stated problem or is for any particular purpose, and it appears that the device would perform equally well with a head portion of either shape.

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7. Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bussler.

Bussler discloses a hand tool with every structural limitation of the claimed invention including a disc (e.g., 5) having opposing edges (e.g., 3, 4 which are generally formed by a 90 degree intersection of two surfaces in the same manner as the present invention) formed by slot (e.g., formed by edges 3, 4) of fixed dimensions which slot continuously narrows toward the center of the disc, and having a handle (e.g., 2).

In the alternative, if it is argued that two of the tools are not disclosed, the Examiner takes Official notice that it is old and well known in the art to provide as many tools as necessary to perform a desired task or tasks. For example, it would have been obvious to one having ordinary skill in the art to provide two of Bussler's tools for various reasons including (1) having a second one as a backup in case a first one breaks or is lost, or (2) having a second one to provide to other users for performing other tasks. It is noted that the recitations directed to how the tools are used together (e.g., "said sides directly touching each other at said edges") has been given little patentable weight since it is clearly an intended use of the disclosed tools.

Further in the alternative, if it is argued that Bussler's tool does not disclose a disc because the term "disc" requires the head portion to be circular, and the head portion of Bussler is not circular, it is the Examiner's position that it would have been an obvious matter of design choice to one having ordinary skill in the art to make the head portions of the tool of Merckens circular since applicant has not stated that providing a circular head portion solves any stated problem or

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is for any particular purpose, and it appears that the device would perform equally well with a head portion of either shape.

Response to Arguments

8. Applicant's arguments filed October 2, 2000 have been fully considered but they are not persuasive.

Regarding the prior art rejection, Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Regarding the rejection under 35 USC 112, the Examiner respectfully disagrees with applicant's position that the two independent hand-held tools constitute "a device". There is nothing about the two tools or their relationship with respect to each other that can be construed as forming a single device. Rather, it is the Examiner's position that each tool is clearly a single device and it is only the recited intended use that requires two of the tools. A situation that may be considered analogous is two wrenches, wherein each wrench constitutes an independent device, and wherein the wrenches can be used simultaneously to tighten/loosen a nut and bolt.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
December 20, 2000